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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,095	10/25/2000	Mitsuharu Kamiya	00754/LH	3189
1933 7590 05/06/2008 FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708				
EXAMINER CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
05/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/696,095

**Applicant(s)**

KAMIYA, MITSU HARU

**Examiner**

Donald L. Champagne

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 63-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-64C)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 February 2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 63-68 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "enables", added with the last amendment (e.g., at claim 63 line 17) is new matter. The examiner did indeed suggest the amendment, but with the following statement:

"This rejection can be overcome by amending "makes" to – enables – and by pointing out the support for this amendment in the specification." (Office action mailed 1 November 2007, para. 3, emphasis in the original.)

4. Applicant did not comply with this requirement to point out the support for this amendment in the specification.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 63-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase, "stored in the print information memory by ... the first user ID" (claim 63 lines 20-21 and claim 66 lines 21-22). It is not clear how "the first user ID" can store anything.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 63-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldridge et al. (US006397261B1).
9. Eldridge et al. teaches (independent claims 63 and 65) a printing information distribution apparatus (*distributed operating environment 100*, col. 3 lines 43-58 and Fig. 1) which is adapted to be operably connected to portable information terminals (*mobile computing devices 118*) and printers (*printer 102*) through a communication network (*networks 116* and *122*), each of the portable information terminals comprising first transmitting means for transmitting through the communication network (col. 3 lines 58-61), and each of the printers comprising a second transmitting means for transmitting through the communication network (col. 3 lines 43-58), the apparatus comprising:

means for storing items of print information (col. 1 lines 61-62 and col.16 lines 20-22);

means for transmitting (col. 9 lines 23-26) to one of the portable information terminals (*mobile computing device 322*) through the communication network a printing reservation screen image (*screen 418*, col. 9 lines 40-42) which enables a user of the one of the portable information terminals to input a reservation request for printing a selected item or

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items of the print information stored in the print information memory "by one of the printers and the first user ID";

means for storing the reservation request and the first user ID/URL identification of the one of the portable information terminals which are input by the user and transmitted through the communication network (col. 10 lines 21-24: the completed *token*, which reads on the reservation request, is stored at the receiving device, *holder device 322*);

distribution means (col. 10 lines 39-50), in response to the second user ID/URL transmitted from one of the printers (*respond to a print request from a mobile computing device 118*), for selecting and reading a reservation request from the reservation request and first user ID/URL storing means which corresponds to the second user ID input identification (*by recovering a document identified by a selected document token*), reading an item or items of print information from the print information storing means which corresponds to the read reservation request, and transmitting the read item or items of print information to the one of the printers which transmits the second user ID/URL (*directing the recovered document to be printed on a printer specified by the mobile computing device*).

10. Eldridge et al. does not explicitly teach first input means for inputting a first user ID of a portable information terminal and second input means for inputting a second user ID of a printer. . However, since the structure recited in the reference is substantially identical to that of the claims, these claimed properties or functions are presumed to be inherent (MPEP § 2112.01). As evidence tending to show inherency, Eldridge et al. does explicitly teach that the portable information terminals/mobile computing devices **118** and the printers **102** are in communication on the Internet (col. 3 lines 43-51). That means each such device must have an Internet address (URL). By the examiner's interpretation (para. 11-12 immediately below), these Internet addresses read on "a first user ID of a portable information terminal" and "a second user ID of a printer". Since said addresses/ user IDs are in device memory, there must have be means for inputting them.

11. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness,

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and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

12. The instant application contains no such clear definition for the phrase "user ID". In the instant case, the examiner is required to give the term "user ID" its broadest reasonable interpretation, which the examiner judges to be any identification of the "user". In the present (apparatus) context, this has to be the ID a system element, such as the *mobile computing devices 118*. The URL of the system element reads on that.
13. Eldridge et al. does not explicitly teach storing the first user ID/URL transmitted from the one of the portable information terminals through the communication network. However, the first user ID/URL must be stored in order to enable communication with said portable information terminals.
14. Claim scope is not limited by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language:
  - "the first user ID input by the first input means" (claim 63 line 7);
  - "which is input by an input operation of a user of the printer" (claim 63 lines 10-11);
  - "the second user ID input by the second input means" (claim 63 line 12);
  - "which corresponds to the second user ID transmitted from the one of the printers" (claim 63 lines 31-32).
15. Eldridge et al. also teaches claims 64 and 67 at the citations given above. The Office respects *functional* distinctions between "advertising" and other content, but no such distinction is claimed. There is no structural distinction between the claimed "advertisement printing" and any other printing, so the reference reads on the claims.
16. Eldridge et al. also teaches claims 65 and 68 at the citations given above, with "a number of pages" taught screen item 920 in Fig. 10 of Eldridge et al., US006421716B1, incorporated

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by reference (as application 09270641) in Eldridge et al. (US006397261B1, col. 1 lines 7-14). The examiner could find no special clear definition for "continuous printing" in the specification, so this term was interpreted as the printing of one sheet after another that state-of-the art printers, such as *printer 102* pictured in Fig. 1 in Eldridge et al. ('261 pat.)

### ***Response to Arguments***

17. Applicant's arguments filed with an amendment on 27 February 2008 have been fully considered but they are not persuasive. The arguments have been addressed by the revised rejection.

### ***Conclusion***

18. This is a continuation of applicant's earlier Application No. 09696095. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

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21. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
23. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
24. Applicant may have after final arguments considered and amendments entered by filing an RCE.
25. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

2 May 2008

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688